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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <div style="font-size: 1.2em; margin-left: 100px;">3032</div>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>11/14/2004</u> <i>Transmitted via Fax 571-273-8300</i> Signature <u><i>Andrew Babcock</i></u> Typed or printed name <u>Andrew Babcock</u>		Application Number <div style="font-size: 1.2em; margin-left: 20px;">10/707,912</div>	Filed <div style="font-size: 1.2em; margin-left: 20px;">1/23/2004</div>
First Named Inventor <div style="font-size: 1.2em; margin-left: 20px;">Sim Wlos</div>		Art Unit <div style="font-size: 1.2em; margin-left: 20px;">2833</div>	
Examiner <div style="font-size: 1.2em; margin-left: 20px;">Leon, Edwin</div>			

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
 Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 44517
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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Telephone number

11/14/2004

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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INTELLECTUAL PROPERTY LAW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: James Wlos
Serial No.: 10/707,912
Filed: 1/23/2004
For: Push-On Connector Interface
Docket Number: 3032
Confirmation No.: 1911

Examiner: Leon, Edwin A
Art Unit: 2833

APPLICANT ARGUMENT FOR PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 14, 2005

Background:

The present novel and nonobvious invention provides a simplified and cost effective quick connect connector interface for use with existing standard threaded connectors (spec. para. 30). Before the present invention, push-on connectors for low power applications, in general, applied outer spring fingers, such as those disclosed in *D'Addario* - a Type F connector, of suspect mechanical reliability and high frequency electrical performance (spec. para. 4). The present invention is the first recognition that the bore surface inner diameter of existing threaded connectors such as Type N or SMA may be utilized according to the invention as a connection and retention surface to reinforce both the mechanical and electrical interconnection of a reliable push-on connection interface according to the invention having the benefit of being usable with these existing standardized threaded connector interfaces.

Argument:

The Examiner rejected claims 1-5 and 7-16 under 35 U.S.C. 103(a) as unpatentable over *Lewis* in view of *D'Addario*. The Examiner provides *Lewis* but concedes that *Lewis* does not show a plurality of spring fingers biased for an interference fit upon the outer diameter surface, the first

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spring located on an outer diameter of the sleeve, the first spring located by a first groove formed in the outer diameter of the sleeve and each of the plurality of spring fingers having an angled face and supplies *D'addario* therefore.

The Examiner admits that the cited references fail to include a first spring located on an outer diameter of the connector body sleeve as claimed. As each and every element of the claimed invention fails to be taught, suggested or disclosed in the cited references these rejection(s) are clear examiner error. The Examiner cites *In re Japikse* for the premise that "rearranging parts of an invention involves only routine skill in the art" and suggests only that it would be obvious to place the outer diameter mounted female connector interface mounted spring(s) of *Lewis* onto an inner diameter male connector interface to satisfy the elements of the present invention (OA 10/19/2005 page 3, para. 3). Applicant respectfully submits that it is settled law, that *In re Japikse* provides no per se obviousness rule, whatsoever, and is narrowly limited to the facts therein where operator buttons had been moved from one area of the machine to another in a way that did not modify the operation of the device, itself. In the present invention, the position of the first spring upon the outer diameter of the connector body sleeve is considerably more than a simple rearrangement in that it solves the problem confronting the inventor at the time of the invention, that is developing a reliable quick connect connection interface usable with existing high power / frequency threaded connectors, which the inventor alone has recognized have a suitable inner diameter contact surface but which include no springs whatsoever (see attachments to applicant(s) response filed 9/15/2005).

Applicant respectfully submits that the Examiner has committed clear error by erroneously applying the requirements of "rearrangement" which appear in the MPEP at 2144.04 VI (C), taking a quote out of context from *In re Japikse* while ignoring the remainder of the MPEP paragraph in which the citation from *In re Japikse* appears. The Examiner has ignored/failed to provide the required motivation for the "rearrangement" he has suggested. With respect to

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"rearrangement", the prior art must provide a motivation or reason for the worker in the art, without the benefit of the applicant's specification, to make the necessary changes to the reference device. *Ex parte Chicago Rawhide Mfg. Co.* 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984), MPEP 2144.04 VI (C)). The BPAI has repeatedly reversed Examiners relying upon a "simple rearrangement" position based upon a citation of *In Re Japikse*, alone, stating that no such per se rule exists.

Further, in his "Response to Arguments" section, the Examiner correctly notes that the test for combining references is what the combination of disclosures taken as a whole would suggest to one skilled in the art. However, in addition to the clear error with respect to "rearrangement" described herein above, the Examiner suggests one skilled in the art would modify *Lewis* with the addition of the spring fingers as taught in *D'Addario* to arrive at the claimed invention "in order to reduce the likelihood of intermittent electrical discontinuity". Applicant respectfully submits that *Lewis* does not suffer from "intermittent electrical discontinuity" and therefore, the Examiner has invented a basis for combination when there is none reflected by the plain language of the combined references. In fact, *Lewis* expounds in multiple places how the design therein is itself an improvement in electrical characteristics over the prior art (See *Lewis*, abstract, last sentence, col. 1, ln 56-66 and col 3 ln 14-24). Therefore, this is not a reasonable basis for the cited combination and further has nothing to do with the problem facing the inventor at the time of the invention, that is developing a reliable quick connect connection interface usable with existing high power / frequency threaded connectors. The mere fact references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills* 916 F.2d 680 (Fed. Cir. 1990).

Applicant respectfully submits that the Examiner has committed clear error by failing to establish a prima facie case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or

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incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital* 732 F.2d 1572, 1577 (Fed.Cir. 1984). Absent a showing in the prior art the Examiner has impermissibly used 'hindsight' occasioned by the applicant's teaching to hunt through the prior art for the claimed elements and combined them as claimed. *In re Zurko* 111 F.3d 887 (Fed.Cir.1997). Therefore, the Examiner's rejection of claim(s) 1-5 and 7-16 under 35 U.S.C. 103(a) is clear error.

Still further with respect to claims 5, 14 and 16 the Examiner has committed another clear error by failing to indicate where the claimed second groove and or second spring are disclosed taught or suggested in the cited references. Applicant respectfully submits that these elements fail to appear anywhere in the cited references. The Examiner appears to have simply ignored the additional claims limitations of these dependent claims, ignoring Applicant's repeated specific requests that each and every element be identified as required. As each and every element of the claimed invention fails to be disclosed, taught or suggested in the cited reference(s), The Examiner's rejection of claim(s) 5, 14 and 16 under 35 U.S.C. 103(a) is clear error.

The Examiner rejected claims 6 and 17 under 35 U.S.C. 103(a) as unpatentable over *Lewis* in view of *D'Addario* and further in view of "applicant's admitted prior art". The Examiner admits *Lewis* and *D'Addario* both fail to disclose that the female connector is either a Type N or SMA connector and suggests it would be obvious to modify the interface of *Lewis* and *D'Addario* by using Type N connectors "to make the connector more versatile". Applicant's arguments against the combination of *Lewis* and *D'Addario*, and the fact that even upon "combination" these references fail to disclose each and every element of the claimed invention, described in detail herein above, also apply here.

Further, making the modifications the Examiner suggests destroys the original purpose / intended connector interface compatibility of each of the cited references. Applicant respectfully submits that "making the connector more versatile" has no meaning whatsoever and therefore is not a

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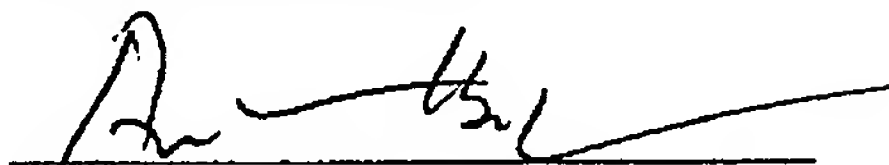
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reasonable basis for supporting the "combination" proposed by the Examiner and further that such motivation appears nowhere in either of the cited references, as required. In fact, the Type N or SMA connectors have no reasonable compatibility and or incentive for combination with the cited references but for the specific teachings of applicant's disclosure, a clear application of improper hindsight by the Examiner. When viewed in the light that the mating interface(s) specified in these dependent claims have none of the elements that the Examiner suggests may be "rearranged" (see attachments to applicant(s) response filed 9/15/2005, the technical specification for Type-N and SMA connectors) the Examiner's basis for rejection is unmistakable clear error.

Because each and every rejection is either clear Examiner error and or omits one or more essential elements required to form a proper Prima Facie obviousness rejection, each of the present rejection(s) should be withdrawn and a notice of allowance issued.

Respectfully submitted,

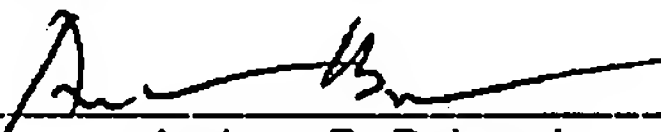


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CERTIFICATE OF TRANSMISSION

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Andrew D. Babcock

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